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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/739,619	12/20/2000	Yusuke Kimata	Q62422	4741

7590 05/19/2003

SUGHRUE, MION, ZINN, MACPEAK & SEAS
2100 Pennsylvania Avenue, N.W.,
Washington, DC 20037

EXAMINER

RAMAKRISHNAIAH, MELUR

ART UNIT	PAPER NUMBER
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2643

DATE MAILED: 05/19/2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.

91

Office Action Summary

Application No.

09/739,619

Applicant(s)

Yusuke Kimata et al.

Examiner

Melur. Ramakrishnaiah

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Feb 28, 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 and 2, are rejected under 35 U.S.C 102(b) as being anticipated by Hiroaki (US PAT: 5,786,846).

Regarding claim 1, Hiroaki discloses a picture-phone device for an operator to exchange images and voices with the party on the other end via a communication circuit comprising: an imaging portion (602, fig. 6), an image display portion (603, fig. 6), and means (102, fig. 6) for guiding the line of sight for guiding the operator's line of sight toward the imaging portion (602) (col. 13 lines 29-67, col. 14 lines 1-26, figs. 13A, 13B, col. 16 lines 14-21).

Regarding claim 2, Hiroaki further teaches the following: indicating means for giving indications to the operator for guiding operator's line of sight (figs. 13A, 13B, col. 16 lines 14-21).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3-7, 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hiroaki in view of Ota (JP363276352A).

Regarding claim 3, Hiroaki teaches control means (102, fig. 8) for controlling indicating means (502, fig. 8) in response to the result of the determination of the phone in use which is implicit (col. 13 lines 42-55, figs. 13A, 13B, col. 16 lines 14-21); but he does not explicitly teach the following: determining whether the phone is in use or not according to a voice input signal output from a microphone.

However, Ota discloses automatic voice dial telephone terminal equipment which teaches determining whether the phone is in use or not according to a voice input signal output from a microphone (see abstract).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Hiroaki's system to provide for determining whether the phone is in use or not according to a voice input signal output from a microphone as this would provide another means to determine phone in use.

Regarding claims 4-8, Hiroaki further teaches the following: indicating means is a light flashing system for guiding the operator's line of sight by light emission, light flashing system is provided near the imaging portion (col. 9 lines 35-42), indicating means is a caption outputting system for projecting a special visual image in order to guide the operator's line of sight (col. 14

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lines 46-57, col. 16 lines 14-21), special visual image is an arrow for pointing to the imaging portion (figs. 13A/13B, col. 15 lines 53-56, col. 16 lines 19-23), a special image is variation of characters, patterns or backgrounds in order to guide the operator's line of sight toward the imaging portion (figs. 9-13, note: all these figures give information to guide operator's line of sight to have proper display of both the remote user and local user in video communication, note: col. 14 lines 5-26).

Regarding claim 9, Hiroaki further teaches the following: the imaging display portion comprising: an inner display field (902, fig. 10) and an outer frame portion (1001, fig. 10, col. 14 lines 26-42).

5. Claim 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hiroaki in view of Leppisaari et al. (EP 0884905A2, hereinafter Leppisaari).

Regarding claim 10, Hiroaki does not explicitly teach the following: imaging portion is disposed with respect to the outer frame portion.

However, Leppisaari discloses a method for producing an image to be transmitted from a terminal and the terminal which teaches the following: imaging portion is disposed with respect to the outer frame portion (fig. 3, page 4 lines 34-35).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Hiroaki's system to provide for the following: imaging portion is disposed with respect to the outer frame portion as this arrangement would provide one of the methods, among many methods possible, to locate imaging portion as taught by Leppisaari.

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Regarding claim 11, Hiroaki further teaches the following: means for guiding operator's line of sight comprises: indicating means for giving indication to the operator for guiding the operator's line of sight (col. 16 lines 14-21).

6. Claims 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hiroaki in view of Leppisaari as applied to claim 11 above, and further in view of view of Ota.

Regarding claim 12, the combination teaches control means (102, fig. 8) for controlling indicating means (502, fig. 8) in response to the result of the determination of the phone in use which is implicit (col. 13 lines 42-55, figs. 13A, 13B, col. 16 lines 14-21 of '846); but it does not explicitly teach the following: determining whether the phone is in use or not according to a voice input signal output from a microphone.

However, Ota discloses automatic voice dial telephone terminal equipment which teaches determining whether the phone is in use or not according to a voice input signal output from a microphone (see abstract).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify the combination to provide for determining whether the phone is in use or not according to a voice input signal output from a microphone as this would provide another means to determine phone in use..

Regarding claims 13-15, the combination teaches the following: indicating means is a light flashing system for guiding the operator's line of sight by light emission (col. 9 lines 35-42 of '846), indicating means is a caption outputting system for projecting a special visual image in

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order to guide the operator's line of sight (col. 14 lines 46-57, col. 16 lines 14-21 of '846), the special visual image is one of the following: an arrow, a variation of characters, patterns or backgrounds in order to guide operator's line of sight (figs. 9-13, note: all these figures give information to guide operator's line of sight to have proper display of both the remote user and local user in video communication, note: col. 14 lines 5-26 of '846).

7. Claims 16-17, are rejected under 35 U.S.C. 103(a) as being unpatentable over Hiroaki in view of Kobayashi (JP35615287A).

Regarding claim 16, Hiroaki does not teach the following: imaging portion is disposed behind the inner display field.

However, Kobayashi discloses a video telephone device which teaches the following: imaging portion (6, fig. 2a) is disposed behind the inner display field (3, see abstract).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Hiroaki's system to provide for the following: imaging portion is disposed behind the inner display field as this arrangement would provide one of the methods, among many methods possible, to locate imaging portion as taught by Kobayashi.

Regarding claim 17, Hiroaki further teaches the following: indicating means for giving indications to the operator for guiding the operators's line of sight (figs. 13A-13B, col. 16 lines 14-21).

8. Claims 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hiroaki in view of Kobayashi as applied to claim 16 above, and further in view of Ota.

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Regarding claim 18, the combination teaches the following: the combination teaches control means (102, fig. 8) for controlling indicating means (502, fig. 8) in response to the result of the determination of the phone in use which is implicit (col. 13 lines 42-55, figs. 13A, 13B, col. 16 lines 14-21 of '846); but it does not explicitly teach the following: determining whether the phone is in use or not according to a voice input signal output from a microphone.

However, Ota discloses automatic voice dial telephone terminal equipment which teaches determining whether the phone is in use or not according to a voice input signal output from a microphone (see abstract).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify the combination to provide for determining whether the phone is in use or not according to a voice input signal output from a microphone as this would provide another means to determine phone in use.

Regarding claims 19-21, the combination teaches the following: indicating means is a light flashing system for guiding the operator's line of sight by light emission (col. 9 lines 35-42 of '846), indicating means is a caption outputting system for projecting a special visual image in order to guide the operator's line of sight (col. 14 lines 46-57, col. 16 lines 14-21 of '846), the special visual image is one of the following: an arrow, a variation of characters, patterns or backgrounds in order to guide operator's line of sight (figs. 9-13, note: all these figures give

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information to guide operator's line of sight to have proper display of both the remote user and local user in video communication, note: col. 14 lines 5-26 of '846).

Response to Arguments

9. Applicant's arguments filed on 2-28-2003 have been fully considered but they are not persuasive.

Rejection of claims 1 and 2 under 35 U.S.C 102(b) - Hiroaki (US PAT: 5,786,846):

Regarding rejection of claims, Applicant alleges that examiner did not address the arguments presented in page 7, third full paragraph of Applicants' Amendment dated August 22, 2002.

Applicant's arguments there in effect speculates that Hiroaki disclosed system is applicable even if the user's back is turned to the camera, or if an inanimate object, rather than a local user, is in camera's field of view. In this regard, the operator would move the object into the camera's field of view without regard to whether or not user's line of sight was also directed towards the camera and he further elaborates on this point. This arguments is based on applicants' own assumptions on the teachings of the Hiroaki reference. Nowhere in the reference is there such a thing mooted.

First of all, Hiroaki clearly states his system is designed to face to face conversation between two users in an video telephone environment to achieve good eye contact (col. 3 lines 21-26). In view of this, Applicants' arguments seems to be spurious because users cannot have face to face conversation in video telephone environment by turning their backs, nor can inanimate objects have face to face conversation. Applicants further refer to figs 13A and 13B of Hiroaki and descriptions therein and make an assumption that Examiner's analyses fails to support the

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rejection. Figs. 13A and 13B, clearly depict indicating means for giving indications to the operator for guiding operators' line of sight by giving an indication to the operator/user to move in proper direction to maintain line of sight (col. 16 lines 14-21). Applicants further argue that "even if, assuming *arguendo*, Hiroaki discloses guiding the operator's line of sight so that operator's position is proper relative to the field of the camera, the local user's eye would not be guided toward the camera. Rather, the local user's eyes would be guided to the corresponding display". It appears that Applicants are mixing up the functions of display and camera.

According to Hiroaki's reference, display is used to give an indication to the operator whether he is in shoot range of camera or not and accordingly use that indication on display to guide the operator to move to the correct camera shoot range to achieve proper line of sight (col. 3 lines 47-62). This is similar to what applicants are using their display for: to give an indication to the user to guide his line of sight as shown in fig. 1 and as described in their summary (page 3 lines 21-24). Applicants further argue that "Hiroaki teaches that video image is changed to indicate the local user that the local user is or is not within the shoot range of camera. Therefore, a user must look at the display to determine whether or not the user knows when the user is in shoot range of the camera. Accordingly, the user's eyes would not be guided to the camera. Clearly, and in contradistinction to Applicants' invention, the Hiroaki approach dictate that the user look at the display, not the camera". Just as stated above, Hiroaki is using the display to give an indication to the user whether or not he is in shoot range of the camera and based on that, operator can move to the camera shoot range to achieve line of sight between the communication partners as shown

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in figs. 13A/13B. Thus use of display in Hiroaki's reference is similar to Applicants' use of display to give an indication to the user by an arrow as shown in fig. 1 as to the direction user has to move to achieve line of sight. One again, it is to be affirmed that Hiroaki's use of display is similar to Applicants' use of display. Applicants make further arguments about Hiroaki's reference such as other means of notifying the user of his deviation from camera's shoot range and come to the conclusion that where the user is looking is unimportant so long as the user is notified, either visually or audibly, that the user is not in shoot range of the camera. The notification is just a means of indicating to the user that he has to move to the shoot range of the camera. Just as Applicants have other means of indicating (such as light flashing system) to the user about his deviation from the camera and prompt him to move correctly to achieve line of sight. In the light of the above explanation, rejection of claims 1-2 is maintained.

Applicants' arguments on dependent claims 3-9, 10-11, 12-15, 16-17, 18-21, are tied to independent claim 1 being patentable. As stated above, rejection of claim 1 is maintained and arguments regarding dependent claims are moot and their rejection is also maintained.

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melur Ramakrishnaiah whose telephone number is (703) 305-1461. The examiner can normally be reached on Monday to Friday from 7 AM to 4 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz, can be reached on (703) 305-4708. The fax phone number for this Group is (703) 305-9508.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

12. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

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(703) 308-6306, (for formal communications intended for entry)

Or:

(703) 305-9508 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington, VA., Sixth Floor (Receptionist).


Melur. Ramakrishnaiah

PRIMARY EXAMINER

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